

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JIMMY F. NEWBY and DAVID W. DOUGLAS

Appeal No. 1998-2858
Application No. 08/355,708

ON BRIEF

Before JERRY SMITH, DIXON, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-20, which are all the claims in the application.

We affirm-in-part.

BACKGROUND

The invention is directed to a timer apparatus for disconnecting a telephone line from a telephone. Claim 15 is reproduced below.

15. A curfew timer apparatus for selectively disconnecting a signal line from an [sic] telephone, the apparatus comprising:

a base;

a three way switch having a movable contact and first and second fixed contacts, the movable contact being movable between a first position in which the movable contact is spaced apart from both the first fixed contact and the second fixed contact to disconnect the signal line from the telephone, a second position in which the movable contact engages the first fixed contact, and a third position in which the movable contact engages the second fixed contact;

means for coupling the signal line to the movable contact of the three way switch;

means for coupling the first fixed contact of the three way switch to the telephone to connect the signal line to the telephone continuously when the movable contact is in the second position;

a timer coupled to the base, the timer being configured to open and close a switch at a preselected time to disconnect the signal line from the telephone during said preselected time periods;

means for coupling the second fixed contact of the three way switch to a first terminal of the switch of the timer; and

means for coupling a second terminal of the switch of the timer to the telephone to connect the signal line to the telephone through the timer when the movable contact is in the third position.

The examiner relies on the following references:

Wilts et al. (Wilts)

4,956,825

Sep. 11, 1990

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|---------|-----------|---------------|
| Laird | 5,062,134 | Oct. 29, 1991 |
| Pawlick | 5,258,656 | Nov. 2, 1993 |

Claims 1-8, 10-13, 15, 16, 19, and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Laird and Pawlick.

Claims 9, 14, 17, and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Laird, Pawlick, and Wilts.

We refer to the Final Rejection (Paper No. 11) and the Examiner's Answer (Paper No. 17) for a statement of the examiner's position and to the Brief (Paper No. 15) and the Reply Brief (Paper No. 18) for appellants' position with respect to the claims which stand rejected.

OPINION

Grouping of Claims

Appellants submit particular groupings of claims on page 5 of the Brief. However, the groupings are not consistent with the arguments presented. Nor do the groupings take into account the two grounds of rejection applied against the claims. A succinct summary of the separate arguments presented appears on the second page of the Reply Brief.

With respect to the section 103 rejection over Laird and Pawlick the grouping is thus: Group I (timer), claims 1-8, 10-13, 15, 16, 19, 20; Group II (flange), claims 3, 10-13, 19; and Group III (three-way switch), claims 8, 13, 15, 16, 19, and 20.

With respect to the section 103 rejection over Laird, Pawlick, and Wilts, the grouping is thus: Group I (timer), claims 9, 14, 17, 18; Group II (flange), claim 14; and Group III (switch), claims 9, 14, 17, 18.

Section 103 rejection over Laird and Pawlick

We first consider appellants' arguments presented against the rejection of claims 1-8, 10-13, 15, 16, 19, and 20 over Laird and Pawlick. Appellants contend, according to pages 8 and 9 of the Brief, that the artisan would not have considered making the "elapsed" timer of Laird into an "on/off timer."

Laird discloses a timer 10 (Fig. 1) that includes a box 20 for placement over a telephone outlet box 64 (Fig. 2). By selectively setting switches in switch set 156, a user controls the cumulative time, during a 24-hour period, that a telephone may be used. As appellants recognize, Laird refers to several U.S. patents, in his description of the prior art, which include the sort of timer claimed by appellants.

In particular, at column 1, line 49 through column 2, line 9, Laird describes U.S. patent 3,925,629 (Albinger), and two patents related thereto. Albinger's patent is referenced as disclosing a timer switch for controlling the delivery of power from an electrical outlet "according to a predetermined on/off schedule."

We consider appellants' reading of the reference as unduly restrictive. That Laird chose one type of timer for his particular application over another type of timer known in

the art does not mean that the artisan would not have recognized the benefits attendant to the other types of timers described by Laird. We find that Laird's disclosure, which includes descriptions of prior-art timers, would have suggested to the artisan the combination claimed by appellants. That is, a timer apparatus for disconnecting a signal from a telephone, including a timer that is configured to open and close a switch at a preselected time, rather than configured to open a switch upon reaching a pre-set cumulative time.

We agree with appellants that Laird does not disclose the claimed combination; i.e., does not anticipate the invention. We also agree with appellants to the extent that Laird does not expressly suggest the combination claimed by appellants. However, the suggestion to modify the art to produce the claimed invention need not be expressly stated in one or all the references used to show obviousness. The test is whether the combined teachings of the prior art, taken as a whole, would have rendered the claimed invention obvious to one of ordinary skill in the art. In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995).

Contrary to appellants' characterization on page 8 of the Brief, Laird does not disclose "that such on/off devices are known for electrical systems to provide for burglary protection...." Laird describes prior art systems, such as Albinger's, as controlling the delivery of power according to an on/off schedule, and mentions nothing of "burglary protection." Nor are we convinced that Laird "found no way to incorporate such into his

device.” The evidence suggests that Laird was not interested in incorporating such a timer because of the inapplicability in the particular problem facing the inventor -- a need to control the cumulative time allowed for the use of a telephone. See Laird, column 2, lines 15-26.

We select instant claim 15 as representative of the subject matter including the argued “timer” and “three-way switch.” See 37 CFR § 1.192(c)(7). There is much verbiage in the claim describing the relationship between the terminals and contacts of the three-way switch and the “switch of the timer.” Properly interpreted, however, the relevant limitations merely set forth a three-way switch with one terminal placed in series with a timer switch, as shown schematically in appellants’ Figure 3. The benefits of being able to bypass a timer switch, and in effect have a regular “on/off” switch, were well known in the art. Laird, at column 2, lines 3-9 describes a prior art invention having such an arrangement. The arrangement was so widely known that we could take official notice of the ubiquitous “on/off/auto” switches found in common, household electrical devices. (See Answer, page 5, “radio/alarm clock.”)

Thus, two of the features argued by appellants as distinguishing over the prior art are found in Laird. The reference fails to disclose the combination set forth in instant claim 15. However, in our view, Laird’s disclosed invention, in combination with his description of the prior art, would have suggested the combination of claim 15, thus rendering obvious

the subject matter as a whole. We consider the teachings of Pawlick to be merely cumulative in the rejection of claim 15.

We select claim 19, depending from claim 15, as representative of the “flange” feature argued by appellants. We do not find the structures pointed out in Laird (Answer, paragraph bridging pages 4 and 5) to be suggestive of the limitations set forth in the claim.

The examiner refers to “base 32,” and “flanges extending from base 32 toward outlet 64 appear to abut the wall, or at least the outlet housing 64.” The examiner thus reads the claimed “base” on Laird’s “cover” 32, as shown in Figures 1 and 2. We agree that the sides of box 20, which extend from cover 32, meet the general requirements of “flanges.” However, in the cross section shown in Figure 2, no part of box 20 is shown as abutting wall 60. How far box 20 may or may not extend is not critical in the Laird invention; at column 4, lines 8-11 he states that the box is “approximately the size of a standard outlet cover plate.” As shown in Figure 2, the edge of box 20, as shown at the top and bottom, does not extend beyond the outlet cover plate. Should the box extend past the plate, it would not abut the wall due to the nature of its mounting to outlet box 64 and the associated cover plate.

Instant claim 19 requires that the base “includes a flange surrounding an outer periphery of the base, the flange being configured to extend below a bottom surface of the base [to] abut the wall surrounding the wall outlet.” In the environment shown in Laird’s Figure 2, additional structure would need to be added to box 20; the structures disclosed

could not abut the wall surrounding the wall outlet. While adding additional structure might, in retrospect, increase security of Laird's device, we do not find suggestion in the prior art applied for the limitations of claim 19.

We therefore do not sustain the section 103 rejection of claims 3, 10-13, and 19. We do, however, sustain the rejection of claims 1, 2, 4-8, 15, 16, and 20.

Section 103 rejection over Laird, Pawlick, and Wilts

In the rejection of claims 9, 14, 17, and 18 (set forth on pages 5 and 6 of the Answer), the examiner adds the teachings of Wilts to those of Laird and Pawlick. Appellants have chosen not to rely for patentability on the "key" features of the relevant claims, for which the examiner turns to Wilts for suggestion.

We note that claim 14 depends from claim 10, which requires, inter alia, that the base includes a flange, and that the means for mounting the base to a wall over a signal wall outlet are such that "the flange abuts the wall surrounding the wall outlet." For substantially the same reasons set forth supra with respect to the limitations of claim 19, we do not agree that the combination of Laird and Pawlick render obvious the subject matter as a whole of claim 14. The teachings of Wilts do not remedy the basic deficiency. We therefore do not sustain the section 103 rejection of claim 14 as obvious in view of Laird, Pawlick, and Wilts.

We select claim 17 as representative of the additional subject matter of the claims, which contains both “timer” and “three-way switch” features argued by appellants. We note that intervening claim 16 recites a “removable, lockable cover coupled to the base.” The limitations are inconsistent with the examiner’s reading of Laird’s cover 32 as the “base.” However, Laird does disclose housing 20, which is no different from the “base” as claimed. Laird also discloses a removable, lockable cover 32; see Figs. 1 and 2, and column 4, lines 26-36.

Claim 17 incorporates the limitations with respect to the timer and the three-way switch that are present in base claim 15. We have determined, for the reasons set forth supra, that claim 15 does not set forth an invention that is nonobvious over the prior art. We agree with the examiner that Wilts suggests a three-position switch with a key for controlling access to the three-position switch, which, in combination at least with Laird, establishes the prima facie obviousness of the combination of claim 17, which includes access through the cover for receiving a key for control of the claimed three-way switch. See Wilts, Figure 2 and column 4, line 41 through column 5, line 8.

In any event, in opposition to the rejection over Laird, Pawlick, and Wilts, appellants in effect rely on the limitations of claim 15 (i.e., the base claim of representative claim 17) to show nonobviousness of the subject matter.¹ Since we are unconvinced that

¹ To the extent appellants’ commentary in the first paragraph of page 9 of the Brief might be considered a separate argument, we do not find it persuasive.

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the rejection of claim 15 is in error, and appellants further have not shown the section 103 rejection of claims 9, 17, and 18 to be erroneous, we sustain the rejection of claims 9, 17, and 18.

CONCLUSION

We have affirmed the rejection of claims 1, 2, 4-9, 15-18, and 20, but have reversed the rejection of claims of claims 3, 10-14, and 19. The examiner's rejection of claims 1-20 is thus affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may
be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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| JERRY SMITH |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JOSEPH L. DIXON |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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